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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/820,612

04/08/2004

Richard A. Sader

200312128-1

8658

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7590

07/02/2007

HEWLETT PACKARD COMPANY

P O BOX 272400, 3404 E. HARMONY ROAD

INTELLECTUAL PROPERTY ADMINISTRATION

FORT COLLINS, CO 80527-2400

EXAMINER

YOON, TAE H

ART UNIT

PAPER NUMBER

1714

MAIL DATE

DELIVERY MODE

07/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/820,612	Applicant(s) SADER ET AL.	
	Examiner Tae H. Yoon	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12,14,15,17-19 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,2,3,3,3,4,3,5,3,6,3,7,3,8,3,9,3,10,3,11,3,12,14,15,17-19 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1714

Notes new examiner.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-11, 15, 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Line 2 of claim 1 recites "at least one anionic phosphate ester surfactant", but "at least one phosphate ester surfactant" is recited in lines 5-6. Thus, said "at least one phosphate ester surfactant" lacks an antecedent basis and such expression is confusing. Claim 15 has the same problem.

The recited "greater than – approximately 2 moles" in claim 4 is indefinite. It has to be either "approximately" or "greater than". See *Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd.*, 18 USPQ 2d 1016 (fed. Cir. 1991). Claim 18 has the same problem.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

Art Unit: 1714

351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 5, 12, 15, 17, 19 and 21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Buckman et al (US 4,176,107).

Rejection is maintained for reason of record with following response.

Contrary to applicant's assertion, quaternary ammonium salt group containing polymer of Buckman et al has inherent capability of reacting with a component of an inkjet ink since said polymer of Buckman et al has the same functional group claimed in the invention. Notes that phosphate esters of ethoxylated linear alcohol or alkylphenol on col. 5, lines 1-2 are anionic surfactants.

Claims 1, 3-5, 11, 12, 14, 15, 17-19 and 21 are rejected, under 35 U.S.C. 103(a) as obvious over Buckman et al (US 4,176,107) in view of Sader et al (US 6,610,129).

Buckman et al also teach employing additional cationic surfactant such as alkyltrimethylammonium halides at col. 5, lines 6-10.

The instant invention further recites nonylphenol (poly)ethoxylated phosphate esters over Buckman et al. However, the instant anionic (poly)ethoxylated phosphate esters are well known in the art as taught by Sader et al, col. 6, line 53-62.

It would have been obvious to one skilled in the art at the time of invention to utilize (nonylphenol poly)ethoxylated phosphate esters of Sader et al in Buckman et al since Buckman et al teach phosphate esters of ethoxylated linear alcohol or alkylphenol and ethoxylated nonyl phenol derivatives on col. 5, lines 1-10

Claims 1, 3-6, 15, 17-19, 21 and 22 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kruckel (US 2004/0206274).

Rejection is maintained for reason of record with following response.

Preferred cationic organic compound (surfactant or polyelectrolyte) includes quaternary ammonium salts of polyamines ([0032]) and the instant anionic phosphate esters are taught in [0028]. Contrary to applicant's assertion, quaternary ammonium salt group containing polymer of Kruckel has inherent capability of reacting with a component of an inkjet ink since said polymer of Kruckel has the same functional group claimed in the invention.

Claims 1, 3-10, 12, 14, 15, 17-19 and 21-24 are rejected under 35 U.S.C. 103(a) as obvious over Ma et al (US 2004/0063808) in view of Sader et al (US 6,610,129).

Rejection is maintained for reason of record with following response.

Art Unit: 1714

Contrary to applicant's assertion, poly(vinyl pyridine) salts of Ma et al contain quaternary ammonium salt group.

Claims 1, 3-12, 14, 15, 17-19 and 21-24 are rejected under 35 U.S.C. 103(a) as obvious over Ma et al (US 2004/0063808) in view of Sader et al (US 6,610,129), and further in view of Hermansky (US 2005/0155516).

Rejection is maintained for reason of record with above response.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tae H Yoon
Primary Examiner
Art Unit 1714

THY/June 25, 2007